

REMARKS**I. General**

Claims 1-7, 9-12, 14-20 and 22 are pending in the Application. Claims 1, 11 and 19 are currently amended. Support for these amendments is found throughout the specification (see e.g. [0031]). No new matter has been added. Applicant respectfully requests reconsideration and allowance of the remaining claims in light of the amendments and remarks contained herein.

II. 35 U.S.C. § 112 Rejection

Claims 1-7, 9-12 and 14-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Examiner is of the opinion that it is unclear whether the parallel limitation of the claim wishes to convey that conveyors of a machine are physically parallel, or that the mailing machine is able to generate indicia while simultaneously processing another mail piece. Examiner assumed the second interpretation to be correct. While Examiner's interpretation reflects an action that the system could accomplish, Examiner's interpretation of the claim language is incorrect. The parallel process is found in that the system is able to generate indicia for an individual mail piece while simultaneously processing that same individual mail piece. Applicant believes that the claims already reflected this interpretation and were sufficiently clear, however, Applicant has amended claims 1 and 11 for the sake of clarity to conveniently advance prosecution.

Claims 1 and 11 were further rejected over an antecedent basis issue. More specifically, claims 1 and 11 recite "the mail piece being physically processed by a mail processing component." Applicant respectfully disagrees with the rejection, as there is sufficient antecedent basis for each term of the recited portion. Applicant notes that the amendment discussed above also further clarifies this claim language. Accordingly, Applicant respectfully submits that the present §112 rejections are overcome.

III. 35 U.S.C. § 103(a) Rejections

A. Rejection over *Freeman* in view of *Leon*

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,742,878 to Freeman et al. (hereinafter *Freeman*) in view of U.S. Publication No. 2001/0042052 to Leon (hereinafter *Leon*). In order for a combination of references to render a claim obvious, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the proposed combination fails to teach all of the claim limitations of claim 1, Applicant respectfully requests that the present rejection be withdrawn.

Claim 1 recites “said postage computing device operable to use said calculated postage value to generate an information based postage indicia for an individual mail piece in parallel with the individual mail piece being physically created and processed by at least one mail processing component.” As an initial matter, the Office Action’s interpretation of the claims, as outlined above, had an adverse effect its substantive rejections. *Freeman* teaches a device that feeds a mail piece to a weighing module, after weighing the mail piece, the postage meter is set, the mail piece is then transferred through the metering system. (see *Freeman* Abstract). It is clear that everything in this process is done in serial. Accordingly, *Freeman* does not teach a device operable to generate information based postage indicia for an individual mail piece in parallel with the mail piece being physically processed.

Further, claim 1 has been amended to recite that the postage based indicia is being generated in parallel with the mail piece being created and processed. This is clearly not taught by *Freeman*. As stated above, everything in *Freeman* is done in a serial fashion. Additionally, *Freeman* clearly requires that the mail piece be printed, folded, inserted, etc. before it goes on to be weighed, and so forth. Further, the *Leon* Reference does not cure this deficiency. For at least the above reasons, the proposed combination fails to teach all of the limitations of claim 1. Accordingly, Applicant submits that the rejection is overcome.

B. Rejection over *Freeman* in view of *Leon* and further in view of *Chang*

Claims 2 and 5-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Freeman* in view of *Leon* and further in view of U.S. Patent No. 5,612,888 to Chang et al. (hereinafter *Chang*). Claims 2 and 5-6 depend directly from claim 1, and thus, inherit the limitations of their corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 1. Further, neither *Leon* or *Chang* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claims 2 and 5-6 obvious.

Further, claim 2 recites “a quality control unit for monitoring the postage value calculated by the postage computing device.” The Office Action relies on *Chang* (col. 3 lines 10-14) to teach this limitation. This portion discusses an error handling task which maintains mail piece integrity in the event that the mailing system experiences a fault. A reading the rest of the *Chang* reference makes clear that the “faults” being monitored by the system are occurrences such as mechanical failure, out of paper, etc. Nothing in *Chang*, teaches performing quality control monitoring of a postage value that is calculated by a computing device.

C. Rejection over *Freeman* in view of *Leon* in further view of *Freeman 2*

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Freeman* in view of *Leon* in further view of U.S. Patent No. 6,041,569 to Freeman (hereinafter *Freeman 2*). Claim 7 depends directly from claim 1, and thus, inherits the limitations of its corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 1. Further, neither *Leon* or *Freeman 2* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claim 7 obvious.

D. Rejection over *Freeman* in view of *Leon* in further view of *Ryan*

Claims 3-4 and 9-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Freeman* in view of *Leon* in further view of U.S. Patent No. 6,173,274 to Ryan, Jr. (hereinafter *Ryan*). Claims 3-4 and 9-10 depend either directly or indirectly from claim 1,

and thus, inherit the limitations of their corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 1. Further, neither *Leon* or *Ryan* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claims 3-4 and 9-10 obvious

Further, claim 4 recites “wherein the mail processing components include a folder and an inserter.” The Office Action admits that *Freeman* does not teach these limitations and relies on *Ryan* to remedy this problem. Applicant respectfully submits that the Office Action fails to address the limitations of this claim in the context of the independent claim. Since the folder and inserter are “mail processing components,” they are physically processing the mail piece *in parallel* with the generation of the information based postage indicia. The indicia of *Freeman* can not be generated until after the mail piece created, folded, inserted in the envelope, and placed on a scale. Thus, adding the teachings of *Ryan* would simply add more steps in an already serialized process. In other words, the proposed combination does not create the claimed invention because merely adding a folder and inserter on the front end of *Freeman*, and maintaining the functionality of *freeman*, would not produce a system which generates an information based postage in parallel with the individual mail piece being physically created and processed by at least one of a folder and an inserter. Therefore, the proposed combination is not proper and does not render claim 4 obvious. *See, In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986) (the prior art can not be modified or combined to reject claims if there is no reasonable expectation of success).

E. Rejection over *Ryan* in view of *Freeman* in further view of *Leon*

Claims 11-12, 15-16 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of *Freeman* in further view of *Leon*. In order for a combination of references to render a claim obvious, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the proposed combination fails to teach all of the claim limitations of independent claim 11, Applicant respectfully requests that the present rejection be withdrawn.

Claim 11 recites “generating an information based postage indicia, using said calculated postage value, for an individual mail piece in parallel with the individual mail

piece being physically processed by one or more of the components including a folder and inserter of said high-speed mail processing system.” The Office Action admits that Ryan does not teach these limitations and relies on *Freeman* to remedy the issue. However, as shown above when discussing claim 1, the Office Action relied on an incorrect interpretation of what is occurring in parallel. That is, the system is able to generate indicia for an individual mail piece while simultaneously processing that same individual mail piece.

Additionally, *Freeman* teaches a device that feeds a mail piece to a weighing module, after weighing the mail piece, the postage meter is set, the mail piece is then transferred through the metering system. (see *Freeman* Abstract). It is clear that everything in this process is done in serial. Accordingly, *Freeman* does not teach a device operable to generate information based postage indicia for an individual mail piece in parallel with the mail piece being processed.

Further, claim 11 has been amended to recite that the postage based indicia is being generated in parallel when the mail piece is being physically processed by one or more of the components including a folder and inserter. This is clearly not taught by *Freeman*, and any combination using *Ryan* and *Leon* does not teach this aspect. For at least the above reasons, *Freeman* fails to teach all of the limitations of claim 1. Accordingly, Applicant submits that the rejection is overcome.

F. Rejection over *Ryan* in view of *Freeman* in further view of *Leon* and *Manduley*

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of *Freeman* in further view of *Leon* and U.S. Patent No. 5,079,714 to Manduley et al. (hereinafter *Manduley*). Claim 14 depends either directly from claim 11, and thus, inherits the limitations of its corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 11. Further, neither *Leon* or *Manduley* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claim 14 obvious.

G. Rejection over *Ryan* in view of *Freeman* in further view of *Leon* and *Chang*

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of *Freeman* in further view of *Leon* and *Chang*. Claim 17 depends either directly from claim 11, and thus, inherits the limitations of its corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 11. Further, neither *Leon* or *Chang* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claim 17 obvious

H. Rejection over *Ryan* in view of *Freeman* in view of *Leon* and *Rasmussen*

Claim 19 is rejected under 35 U.S.C. § 103(a) as being anticipated by *Ryan* in view of *Freeman* in view of *Leon* and U.S. Publication No. 2004/0088267 to Rasmussen et al. (hereinafter *Rasmussen*). As amended, claim 19 recites “said weights determined, and postage value calculated, without weighing the individual mail piece using information from said processing instructions, and in parallel with the high-speed processing of said mail piece.” Applicant respectfully submits that nothing in the cited art teaches using processing instructions to calculate postage by determining weight without weighing the individual mail piece in parallel with the controlling the high-speed processing of the mail piece. Additionally, as shown above, a combination of *Freeman*, *Ryan*, and *Leon* does not create a system having parallel capabilities. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

I. Rejection over *Ryan* in view of *Freeman* in further view of *Leon* and *Rasmussen* and *Official Notice*

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of *Freeman* in further view of *Leon* and *Rasmussen* and *Official Notice*. Claim 20 depends from claim 19, and thus, inherits the limitations of its corresponding independent claim. As shown above, the proposed combination fails to teach all of the limitations of claim 19. Therefore, the proposed combination, even if proper, fails to render claim 20 obvious.

Further, Applicant asserts that the Office Action's taking of official notice is improper. The Office Action asserts that "a high-speed printer capable of printing the postage value at any position or orientation on the email pieces is old and well known" (*see* Office Action pg 11). Generally, mailing systems must singulate the pieces and orient them so as to align with the postage printer. It is noted that the *Freeman* reference singulates the mail pieces and uses a printer that requires mail pieces oriented prior to printing. (*See Freeman* abstract, Fig. 1). Additionally, the system taught in *Ryan* illustrates that the mail pieces are oriented, thereby not needing a printer of the type recited in claim 20. (*See Ryan* Fig 1). In fact, six different references have been applied in the present action, and none of them contemplate what is being asserted as well known. Accordingly, Applicant respectfully requests documentation pursuant to M.P.E.P. 2144.03 showing a printer in a high-speed mail processing system capable of printing the postage value at any position or orientation on the mail pieces.

J. Rejection over *Ryan* in view of *Freeman* in further view of *Leon* and *Rasmussen*

Claim 22 is rejected under 35 U.S.C. § 103(a) as being anticipated by *Ryan* in view of *Freeman* in further view of *Leon* and *Rasmussen*. Claim 22 depends from claim 19, and thus, inherits the limitations of its corresponding independent claim. As shown above, the proposed combination fails to teach all of the limitations of claim 19. Therefore, the proposed combination, even if proper, fails to render claim 22 obvious.

IV. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P019US/10303184 from which the undersigned is authorized to draw.

Dated: February 13, 2008

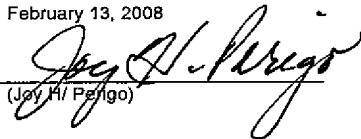
Respectfully submitted,

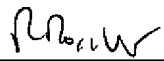
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: February 13, 2008

Signature: _____

(Joy H. Perigo)



By  _____

R. Ross Viguet

Registration No.: 42,203

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue, Suite 2800

Dallas, Texas 75201-2784

(214) 855-8185

(214) 855-8200 (Fax)

Attorney for Applicant